

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE

Serial Number: 09/360,719

Filing Date: July 27, 1999

Title: CALL MANAGEMENT SYSTEM WITH CALL CONTROL FROM USER WORKSTATION COMPUTERS

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REMARKS

No claims are amended, no claims are canceled, and no claims are added; as a result, claims 1, 4-7, 17-24, 27-30, 36, 139, 142-157, 270-273, and 283-286 are now pending in this application.

§103 Rejection of the ClaimsApplicable Law

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The *Fine* court stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re*

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Vaech, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. The Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

Still further, the Office Action must provide specific, objective evidence of record for a finding of a teaching, suggestion, or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

Claims 1, 4-7, 17-23, 27-29, 270-273, and 283-286

Claims 1, 4-7, 17-23, 27-29, 270-273, and 283-286 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Robinson *et al.* (U.S. 5,533,102) in view of Bobo II (U.S. 6,564,321). Applicants traverse this rejection for the reasons set out below.

THERE IS NO SUGGESTION OR MOTIVATION TO COMBINE THE REFERENCES

The Office Action based the rejection of claims 1, 4-7, 17-23, 27-29, 270-273, and 283-286 on the combination of Robinson *et al.* and Bobo II. As noted above, the Office Action must provide specific, objective evidence of record for a finding of a teaching, suggestion, or motivation to combine the reference teaches and must explain the reasoning by which the evidence is deemed to support such a finding. In an attempt to meet these requirements, the Office Action on page 4 states,

management computer includes means for identifying a call type for the incoming call. However, Bobo teaches this limitation (see abstract). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Robinson with the identifying means taught by Bobo. This modification would have improved the versatility of Robinson by allowing the auto attendant system to receive various kinds of messages as suggested by Bobo.

The Applicants disagrees with these statements. The Office Action admits that Robinson *et al.* does not disclose a call management computer including means for identifying a call type of the incoming call. The Applicants agree with this statement. The mere fact that the abstract of Bobo II discloses "The MSDS detects the type of call and stores the message signal in a

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database" fails to provide a teaching, suggestion, or motivation to combine Robinson *et al.* with Bobo II. Further, the Office Action fails to point out, and the Applicants' representatives fails to find in Robinson *et al.*, any disclosure that Robinson *et al.* is concerned with expanded versatility regarding various kinds of messages. Therefore, the statements in the Office Action are unsupported by the cited documents. Thus, the Office Action fails to point to any teaching or suggestion to make the claimed combination and the reasonable expectation of success that is found in the cited documents and not merely based on the Applicants' disclosure. Therefore, the statements made in the Office Action for the proposed combination of Robinson *et al.* and Bobo II represent mere reconstruction of the Applicants' claimed invention using impermissible hindsight. Because the Office Action fails to state an adequate grounds for forming the combination of Robinson *et al.* with Bobo II, the Office Action fails to state a *prima facie* case of obviousness with respect to claims 1, 4-7, 17-23, 27-29, 270-273, and 283-286.

THE CITED REFERENCES DO NOT TEACH EVERY ELEMENT OF CLAIMS

In addition, the Office Action fails to state a *prima facie* case of obviousness even if the proposed combination of Robinson *et al.* and Bobo II were made because the proposed combination fails to teach or suggest each of the elements of claims 1, 4-7, 17-23, 27-29, 270-273, and 283-286.

Claim 1 recites, "wherein said at least one processing rule is selected based on at least one of the call type and the calling party. (emphasis added). The portion of the specification cited by the Office Action as teaching the limitation is Figure 5. In particular, the Office Action on page 4 states, "Units 124, 126, 128, 130, 132 and 134 of Robinson are functionally equivalent to the claimed call-processing rules because these options determine how an intercepted call is to be processed. Because the called party may choose one of these options (122), Robinson discloses the claimed selecting limitation." The Applicants respectfully disagree.

The Office Action specifically acknowledges on page 4 that Robinson does not disclose a means for identifying a call type for incoming calls. Therefore, it stands to reason that Robinson *et al.* cannot teach or suggest selecting a processing rule based on the **call type**. Further, Robinson *et al.* at column 8, line 60 through column 9, line 10 states,

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After completing the call answering and identification stage, the apparatus 10 visually notifies the called party and initiates call transfer (block 116). The visual notification announces the call to the called party and presents the called party with options. These options may include 1) for the apparatus 10 to ask the caller to hold, 2) for the apparatus 10 to reroute the call to a substitute called party designated to accept the call, 3) for the apparatus 10 to take a message from the caller, and 4) for the called party to accept the call. The called party may choose one of these options or not (block 122). Depending upon the option chosen (if any), the apparatus 10 exercises holding options and actions (block 124), exercises rerouting options and actions (block 126), takes a message (block 128), or passes the call to the called party (block 130). If the called party does not choose an option, the apparatus 10 cancels the connection (block 132) and transfers the call to the voice mail subsystem of the call processor system 38 (block 134). (emphasis added).

Thus, Robinson *et al.* discloses presenting the called party with options, from which the called party is free to select one of the options or not. There is no teaching or suggestion in Robinson *et al.* that the selection made, if one is made, by the called party is in any way based on the **calling party**. The called party of Robinson *et al.* is free to choose one of the presented options at will. Further, if no option is chosen, the call in Robinson *et al.* is transferred to the voice mail subsystem of the call processor system. Again, there is no teaching or suggestion in Robinson *et al.* that if no option is chosen, any processing of the call is based on the **calling party**.

Therefore, there is no teaching or suggestion in Robinson *et al.* that at least one processing rule is selected based on the **call type** or on the **calling party**, and thus Robinson *et al.* fails to teach or suggest "wherein said at least one processing rule is selected based on at least one of the call type and the calling party," as recited in claim 1.

Bobo II, in the abstract portion cited in the Office Action, states the following:

A Message Storage and Deliver System (MSDS) is connected to the public switched telephone network (PSTN) and receives incoming calls with these calls being facsimile, voice, or data transmissions. The MSDS detects the type of call and stores the message signal in a database. The MSDS is also connected to the Internet and has a hyper-text transfer protocol daemon (HTTPD) for receiving requests from users. The HTTPD forwards requests for certain files or messages to a network server which transmits at least part of the message to the HTTPD and then to the user.

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In addition to requests for certain documents, the HTTPD may also receive a request in the form of a search query. The search query is forwarded from the HTTPD to an application program for conducting the search of the database. The results of the search are forwarded through the HTTPD to the user. The user may then select one or more files or messages from the search results and may save the search for later reference.” (emphasis added).

While the Applicants agree that Bobo II discloses a Message Storage and Delivery System (MSDS) that detects a call type, there is no disclosure in the cited portion of Bobo II of a processing rule being selected based on a detected call type. Accordingly, Bobo II fails to cure the deficiencies of Robinson *et al.* Specifically, the combination of cited portions of Robinson *et al.* and Bobo II fail to teach or suggest **at least one processing rule is selected based on at least one of the call type and the calling party**, as recited in claim 1.

For at least the reasons stated above, the Applicants respectfully submit that the rejection of claim 1 has been overcome.

Claims 4-7, 17-23, 27-29, 270-273, and 283-286 all depend from claim 1, and claim additional limitations upon the call management system. According to the arguments presented above for claim 1, the Applicants respectfully submit that the rejections of claims 4-7, 17-23, 27-29, 270-273, and 283-286 under 35 U.S.C. § 103(a) have been addressed by the arguments presented above with respect to claim 1. Therefore, the Applicants respectfully request withdrawal of the rejection and reconsideration and allowance of claims 1, 4-7, 17-23, 27-29, 270-273, and 283-286.

Claims 24 and 30, Claim 36, Claims 139 and 142-156, Claim 157, and Claim 151

Claims 24 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Robinson *et al.* combined with Bobo II in further view of Klingman (U.S. 5,721,729). Claim 36 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Robinson *et al.* combined with Bobo II in further view of Monnot *et al.* (U.S. 5,432,618). Claims 139 and 142-156 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Robinson *et al.* combined with Bobo II in further view of Pepe *et al.* (5,742,905). Claim 157 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Robinson *et al.* combined with Bobo II and Pepe *et al.* in further view of Kondo *et al.* (U.S. 5,490,205). Claim 151 was rejected under 35 U.S.C. § 103(a).

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as being unpatentable over Robinson *et al.* combined with Bobo II and Pepe *et al.* in further view of Norris *et al.* (U.S. Publication No. 2002/0080776). Applicants traverse these rejections for the reasons set out below.

THERE IS NO SUGGESTION OR MOTIVATION TO COMBINE THE REFERENCES

In each of the above rejections, the Office Action bases the rejection of the claims on a combination that includes Robinson *et al.* combined with Bobo II and one or more additional documents. However, in each instance, the Office Action fails to provide any additional grounds for forming the combination of Robinson *et al.* with Bobo II, and merely makes a statement adding the additional document or documents. As noted above, the Applicants submit that the Office Action fails to provide a proper grounds for forming the combination of Robinson *et al.* and Bobo II with respect to claims 1, 4-7, 17-23, 27-29, 270-273, and 283-286. Therefore, the Applicants respectfully submit that the Office Action has failed to state a proper ground for forming the combination of Robinson *et al.*, Bobo II, and Klingman with respect to claims 24 and 30, and fails to state a proper grounds for forming the combination of Robinson *et al.*, Bobo II, and Monnot *et al.* with respect to claim 36, and fails to state a proper grounds for forming the combination of Robinson *et al.*, Bobo II, and Pepe *et al.* with respect to claims 139 and 142-156, and fails to state a proper grounds for forming the combination of Robinson *et al.*, Bobo II, Pepe *et al.*, and Kondo *et al.* with respect to claim 157, and fails to state a proper grounds for forming the combination of Robinson *et al.*, Bobo II, Pepe *et al.*, and Norris *et al.* with respect to claim 151.

Further, the Office Action makes the following statements:

on page 6 with respect the rejection of claims 24 and 30:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify Robinson combined with Bobo with means for identifying fax calls by detecting ISDN messages as taught by Klingman. This modification would improve the accuracy of Bobo by providing a universal call processing system that can detect and process all information types transmitted through a telephone line via an ISDN network.

on page 7 with respect to the rejection of claim 36:

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Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify Robinson combined with Bobo to include a system wherein an identified message is returned to the calling fax machine which confirms the identity of the called party as taught by Monot [sic]. This modification would have improved the reliability of Bobo by allowing for certification of fax transmissions.

on pages 7-8 with respect to the rejection of claims 139 and 142-156:

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Robinson combined with Bobo with a system wherein the types of calls determine, at least in part, the at least one call processing rule as taught by Pepe. This modification would improved [sic] the flexibility of Robinson by allowing the user to establish a set of rules that specify how the user is to be notified of various types of messages as suggested by Pepe (see col. 5, line 60 to col. 6, line 35).

on page 9 with respect to the rejection of claim 157:

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify Robinson combined with Bobo and Pepe to include a system wherein a call processing rule specifies at least in part that a special ringing sound should be used for a call as taught by Kondo. This modification would have improved the cumulative features of the system by allowing a user to know whether or not a caller is important to him.

on page 10 with respect to the rejection of claim 151:

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination Robinson, Bobo and Pepe with a system wherein the other destination is a destination on the Internet as taught by Norris. This modification would allow for calls to be received via an Internet Phone as suggested by Norris.

The Applicants respectfully disagree with each of these statements. In each of these statements, the Office Action fails to point to any teaching or suggestion found in the cited documents to make the claimed combination and the reasonable expectation of success as found in the cited documents. In each instance, the Office Action attempts to combine the documents by merely restating that the combination would include the elements recited in the respective rejected claims, and then in each instance recites an alleged benefit that would motivate one of

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ordinary skill in the art to form the proposed combination. Because the Office Action fails to point to any portion of the cited documents that provide a teaching or suggestion to make the claimed combination and the reasonable expectation of success found in the prior art that is not merely based on the Applicants' disclosure, the Office Action fails to state a proper grounds, in each of the above mentioned proposed combination, for forming the proposed combination of documents.

Because the Office Action fails to state a proper grounds for forming the proposed combination of documents used in the rejections of claims 24 and 30, claim 36, claims 139 and 142-156, claim 157, and claim 151, the Office Action fails to state a *prima facie* case of obviousness with respect to claims 24 and 30, claim 36, claims 139 and 142-156, claim 157, and claim 151.

THE CITED REFERENCES DO NOT TEACH EVERY ELEMENT OF CLAIM

In addition, the Office Action fails to state a *prima facie* case of obviousness even if the proposed combination of Robinson *et al.* and Bobo II with each of the additional documents were made in the rejections of claims 24 and 30, claim 36, claims 139 and 142-156, claim 157, and claim 151 because the proposed combinations still fail to teach or suggest each of the elements of claims 24 and 30, claim 36, claims 139 and 142-156, claim 157, and claim 151.

Claims 24, 30, 36, 139, 142-156, 157, and 151 all depend from claim 1, and claim additional limitations upon the call management system. According to the arguments presented above for claim 1, the Applicants respectfully submit that the rejections of claims 24, 30, 36, 139, 142-156, 157, and 151 under 35 U.S.C. § 103(a) have been addressed and overcome by at least the arguments presented above with respect to claim 1.

Therefore, the Applicants respectfully request withdrawal of the rejections and reconsideration and allowance of claims 24, 30, 36, 139, 142-156, 157, and 151.

Reservation of Rights

Applicants do not admit that references cited under 35 U.S.C. §§ 102(a), 102(e), 103/102(a), or 103/102(e) are prior art, and reserves the right to swear behind them at a later

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date. Arguments presented to distinguish such references should not be construed as admissions that the references are prior art.

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CONCLUSION

The Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney 408-846-8871 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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7/19/2005

By



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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being sent via facsimile to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 19th day of July, 2005.

Dawn R. Shaw

Name

Signature



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